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James W. Wieder

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JAMES W. WIEDER

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

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3694

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,879	Applicant(s) WIEDER, JAMES W.	
	Examiner DANIEL L. GREENE	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 101-140 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 101-140 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon further consideration and deliberation of the references submitted in the IDS received 10/30/2007, **the Finality of the previous Final Office action mailed 2/5/2008 is hereby withdrawn and replaced with the instant Office action.**
2. The cancellation of all previous claims and the addition of new claims 101-140 is acknowledged.
3. The Examiner would like to point out that it is not necessary to cancel all previous claims in order to enter new claims. Old claims can be amended with the addition of proper claim modifiers, i.e. (currently amended), (previously presented), etc. Typically new claims require more scrutiny than previously presented claims that have been amended because new claims may contain improper grammar, new 35 USC 112/101 issues that were previously corrected, new matter, etc.
4. An action on the merits of new claims 101-140 follows.

Admission of Prior Art under MPEP § 2144.03 [R-1] C

Because applicant failed to traverse the Examiner's assertion of what is common knowledge or well known in the art the following item(s) is/are, from this point forward, to be considered prior art:

5. From page 5 of the previous Office action "...the Examiner takes Official Notice that it was well known at the time of invention to one of ordinary skill that iTunes coupled with an iPod or other networked computers generated, consolidated and distributed musical compositions, playlists (including "Smart Playlists") and user usage data (such as "Ratings") to tailor Smart

Playlists to the user at any device on the media network, and that customization and tracking information was recorded individually by each user's own iTunes Library.”

Specification

6. The amendments to the abstract and specification appear acceptable.

Claim Objections

7. Claim 121 is objected to because of the following informalities:

As discussed in the interview, each method step in a method claim must start with active method step. the second through fourth steps of claim 121 are not in proper active method step format. Examples are “capturing automatically...updating continuously...providing a piece or composition automatically...”, etc. Applicant’s submission of new claims required this objection to be made.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 101-140 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

a. Claims 101, 121 and 140 are vague, indefinite and incomplete in what all is meant by and encompassed by the phrase “providing a sequence of entertainment pieces of compositions” because a sequence is never provided by the claim. That is, the last limitation discloses “selecting automatically pieces or compositions...” but does not disclose a “sequence” per se. Since the claim does not disclose that a sequence is actually generated the metes and bounds of the claim are undefined. Applicant’s submission of new claims required this rejection to be made.

b. Claims 101, 121 and 140 recite the limitation “said user’s preferences ” in the second limitation. There is insufficient antecedent basis for this limitation in the claim because no preferences were set forth previously. That is, “applying different actions...by a user” does not specifically connote “preferences”. Applicant’s submission of new claims required this rejection to be made.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Applicant is advised that should claims 101-120 be found allowable, claims 121-139 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant's submission of new claims required this rejection to be made.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 101-140 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 101, 121 and 140 are drawn to a method and apparatus that can and is performed by human beings everyday. The claims do not explicitly set forth, nor require that a computer network or a machine performs all of the steps necessary to perform said method. Since the claims can be construed that an actual person is performing said method steps, then it appears applicant is attempting to claim the person performing said act. Further claim 140 can be understood to read on a person as the user interface is the ears and fingers and the processing capability is the person's brain. People are not statutory subject matter and as such the claims are rejected as being **directed to non-statutory subject matter**.

All claims that depend from claims 101 and 121 are rejected for depending from a rejected base claim.

Claim Rejections - 35 USC § 102

11. Claims 101, 103-113, 117, 120, 121, 123-134, 139 and 140 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 7,146,329 to Conkwright et al. (Conkwright).

Regarding claims 101, 121 and 140, Conkwright discloses a method and apparatus for providing a sequence of entertainment pieces or compositions (Abstract), the method comprising:

- applying different actions on pieces or compositions by a user (See, figures 19, 20, Col. 4 lines 15-33, etc.);
- capturing automatically said user's preference based on said step of applying different actions on said pieces or compositions (see for example, Col. 4 lines 5-14);
- updating continuously said user's preference using said different actions on said pieces or compositions by said user (see for example, Col. 9, lines 37-44); and
- selecting automatically pieces or compositions based on said updated user's preferences (see, for example, the last sentence of the Abstract).

Regarding claims 103 and 123, Conkwright monitors the programs accessed by the user, therefore the term "select a particular piece for playback" is the same as changing the channel to the station that the desired program is being played on.

Regarding claims 104-110 and 124-130, see for example, Col. 3 lines 52-55.

Regarding claims 111-113 and 131-133, see for example, Col. 9 lines 29-35.

(NOTE, this limitation was Admitted as Prior art as set forth in section 3 above.)

Regarding claims 117 and 134, Conkwright is monitoring user's actions and inherently maintaining a history of such, see Abstract.

Regarding claims 120 and 139, the whole point of Conkwright is to monitor user's preferences and direct material to target groups of users. Current television programming utilizes the "Neilson ratings" to help determine/provide television content. See, for example, Column 33 lines 22-25, Col. 35 lines 11-14, etc.

Claim Rejections - 35 USC § 103

12. Claims 101-140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of In re Venner, 120 USPQ 192 (CCPA 1958) and In re Rundell, 9 USPQ 220.

APA discloses in, for example, paragraphs [0007]-[0017] that it is known for users to manually select their own entertainment sequences based on their own personal preferences. Further, APA sets forth the well known complications of transferring media from one area to another (i.e. home to car, car to work, etc.) for continuing enjoyment.

Resort may be had to case law to show that there is no novelty in simply automating a process previously done manually and/or combining a series of steps that were previously done individually.

See *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Smith*, 73 USPQ 394

“If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention”,

In re Rundell, 9 USPQ 220

“It is not ‘invention’ to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result”,

and *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961))

“It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable”

This appears to be exactly what applicant has done, automated the process of personal preference on entertainment media. For example, the instant Examiner does not fully appreciate country music, therefore when subject to country music the Examiner changes the (radio/television) station and wishes there was some way to prevent this situation from arising. The Examiner personally appreciates Applicant’s invention, however it is not seen wherein applicant has “invented” something novel and unique, merely automated something we all do naturally.

All dependent claims are rejected for merely verbalizing actions performed by the person. For example, it is considered that the more a person loathes a specific type of music, the faster they will try to get it shut off. Another example is when children listen to the same song or watch the same movie over and over and over again.

13. Claims 102, 114-116, 118, 119, 122, 134-136 and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,146,329 to Conkwright et al. (Conkwright) as applied to claims 101, 121 and 140 above and further in view of Cohen and Fanning.

Regarding claims 102 and 122, Conkwright discloses applicant's invention as set forth above. Even though Conkwright discloses monitoring users actions, he does not appear to expressly disclose wherein said user's preference is at least partially based on user action to "repeat; replay; or go-back to" a piece or composition that previously played.

Cohen and Fanning disclose that it is known in the art to utilize playlists, last played and play count data for determining when to "randomly play your most recently listened-to tracks." (Fanning, page 1, second paragraph).

At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize the teachings of Fanning and Cohen and to apply them to Conkwright for the benefits of allowing Conkwright to accurately monitor the actions of a user as such is no more than another means of collecting data utilized by the Conkwright invention.

Regarding claims 114-116 and 134-136, see Fanning, "My Rating". Ratings are used to, for example, aid in determining the frequency of "automatic" playback based on playcount, last played, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize the teachings of Fanning and Cohen and to apply them to Conkwright for the benefits of allowing Conkwright to more accurately monitor the actions of a user as

such is no more than another means of “collecting data” utilized by the Conkwright invention.

Regarding claims 118, 119 and 139, see Fanning and Cohen playlists, playcount, ratings, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize the teachings of Fanning and Cohen and to apply them to Conkwright for the benefits of allowing Conkwright to more accurately monitor the actions of a user as such is no more than another means of “collecting data” (that the Conkwright invention deems important.)

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schoen et al. teaches that it is OLD AND WELL KNOWN (1996) for people to want to be in control of their own music and make customized albums. Customized albums back then (1996) are synonymous with playlists today.

2007 IBM- Automatic Music Selection teaches it is known to select music with relation to speed and music tempo.

1980 IBM- Home (computer) Terminal Music Program Selection teaches automated music selection.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel L Greene Jr./
Examiner, Art Unit 3694
2008-01-22

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694